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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/653,966	09/01/2000	Daniel R. Salmonsen	003551.P015	5668

7590 04/22/2004	EXAMINER

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ART UNIT	PAPER NUMBER
2134	

DATE MAILED: 04/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _01 September 2000_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-25_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-25_ is/are rejected.

7)☒ Claim(s) _8,15,16,19 and 22_ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _01 September 2000_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   Claims 1-25 are pending.

Specification

2.   The abstract of the disclosure is objected to because:

(1) "from a secure" should be replaced with "from a secure medium" or similar change

(2) "including" should be replaced with "includes"

Correction is required. See MPEP § 608.01(b).

Claim Objections

3.   The claims are objected to because they include reference characters which are not enclosed within parentheses.

Reference characters corresponding to elements recited in the detailed description of the drawings and used in conjunction with the recitation of the same element or group of elements in the claims should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. See MPEP § 608.01(m). Claims 1-25 contain reference to "ID", where reference should be made to "identification". For instance claim 17, line 4 should read "an encryption logic to send the identification and content from a secure medium;".

4.   Claims 15, 16 & 19 are objected to because of the following informalities:

Regarding claim 15, the claim depends upon itself. Claim 16 is objected to due to its

dependence on claim 15. *For the purposes of this office action, the claim is understood to*

depend from claim 14.

Regarding claim 19, "key send" should be replaced with "key sent". Appropriate

correction is required.

Claim Rejections - 35 USC § 112

5.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6.   Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which

is not enabling. The "application" critical or essential to the practice of the invention, but not

included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188

USPQ 356 (CCPA 1976). Figs. 1, 3 & 7 demonstrate that the "application" is considered

essential by the applicant to correctly perform the steps of claim 1 of the invention, but is omitted

from the claim. Claims 2-16 are rejected based on their dependency upon claim 1.

7.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8.   Claims 1-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which applicant regards as

the invention.

    a.   Regarding claim 1, it is unclear how the session key is received only if

authenticated, when the session key was previously sent to the server and is therefore

already possessed. Claims 2-16 are rejected based on their dependency upon claim 1.

    b.   Regarding claim 2, it is unclear how claim 2 relates to claim 1, as there is nothing

to tie claim 2 to claim 1. Claim 3 is rejected based upon its dependence on claim 3.

    c.   Regarding claim 17, it is unclear whether more than one "read ... content" is

occurring because the step of reading appears to happen twice (line 3 and line 7). Claims

18-24 are rejected based upon their dependency upon claim 17.

9.   Claim 7 recites the limitation "the application" in line 2 of the claim. There is

insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

10.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
> in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
> patent by another filed in the United States before the invention by the applicant for patent, except that an
> international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this
> subsection of an application filed in the United States only if the international application designated the United
> States and was published under Article 21(2) of such treaty in the English language.

11.   Claims 1-6 & 10-16 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S.

Patent 6,499,106 to Yaegashi et al. (Yaegashi). Yaegashi discloses determining a secure

medium identification (disk ID) from a secure medium (col. 10 lines 47-65) including

content/sensitive information (col. 8 lines 61-67), sending the ID to a server/central access

control system (col. 9 lines 20-28), requesting user authentication (col. 10 lines 47-65), and if the

user is successfully authenticated, receiving a session key/decryption key from the server to

enable reading of the content on the secure medium (col. 11 lines 1-22).

Regarding claims 2 & 3, Yaegashi discloses streaming/sending the content to an

application/information access system that uses the session key/decryption key to decrypt and

display the content (col. 11 lines 12-22).

Regarding claim 4, Yaegashi discloses the content stored as encrypted content on the

secure medium (col. 11 lines 1-22).

Regarding claims 5 & 6, Yaegashi discloses receiving a content decryption key from the

server, in response to the disk ID/disc identification information and the user authentication (col.

10 lines 47-65) wherein the content decryption key is determined based on the disk ID/disc

identification information (col. 12 lines 29-50).

Regarding claim 10, Yaegashi discloses a CD (col. 11 lines 1-22).

Regarding claim 11, Yaegashi discloses digitally encoded music (col. 1 lines 44-59 &

col. 4 lines 17-41).

Regarding claim 12, Yaegashi discloses the use of a credit card for unlocking of copy-

protected software, but lacks specific disclosure of using a credit card for authentication.

However, official notice is hereby taken that it was well-known in the art to authenticate online

purchases based on a credit card to allow royalties to be collected. Therefore, it would have been

obvious to one having ordinary skill in the art at the time the invention was made to authenticate

via credit card. One of ordinary skill in the art would have been motivated to perform such a

modification to allow royalties to be collected as was well-known in the art.

Regarding claim 13, Yaegashi discloses a password used for authentication (col. 10 lines

47-65).

Regarding claim 14, Yaegashi discloses determining if the disk ID is already associated

with a user (col. 12 lines 4-17) and if the disk ID/disc identification information is not yet

associated with the user, associating the user authentication data/login identity with the disk

ID/disc identification information (col. 12 lines 4-17 & lines 56-61).

Regarding claim 15, Yaegashi discloses determining that the current user authentication

matches the user (validation/authentication by determining if the user matches a key for the

current disk) (col. 10 lines 47-65 & col. 12 lines 4-8) in addition to determining if a user is

associated with the disk ID/disc identification information (col. 12 lines 4-17).

12.   Regarding claim 16, Yaegashi discloses that if validation is unsuccessful, the session

key/content key is not returned (col. 11 lines 5-10).

13.   Claims 17 & 18, as best understood, are rejected under 35 U.S.C. 103(a) as being

unpatentable over U.S. Patent 6,636,966 to Lee et al. (Lee) in view of U.S. Patent 6,236,727 to

Ciacelli et al. (Ciacelli).

Regarding claim 17, Lee discloses a reader/data storage engine (Fig. 1 #14) to read an

identification (ID)/identification of content to enable (Fig. 3A #31) and content/data stored on a

storage medium (col. 2 lines 49-67), encryption logic (Fig. 2C'1) to send the identification to a

server/content key server (col. 9 lines 17-26) in encrypted form (col. 9 lines 39-46), an

authentication logic to receive authentication from the server/content key server indicating

approval to read the content of the secure medium/storage medium (col. 9 line 63 – col. 10 line

3) and sending the content to an application/host (Fig. 2C'1 & Fig. 2B #254). Lee lacks the

encryption logic encrypting the content prior to sending the content to an application/host.

However, Ciacelli teaches the well-known concept that encrypting a data stream, one ensures

that the information in the stream (such as copyrighted material) is not exposed during the data

transfer (col. 3 lines 25-64). Therefore, it would have been obvious to one having ordinary skill

in the art at the time the invention was made to encrypt the content prior to sending the content to

an application. One of ordinary skill in the art would have been motivated to perform such a

modification to ensure that the content is not exposed during data transfer, as taught by Ciacelli

(col. 3 lines 25-64).

Regarding claim 18, Lee discloses using a symmetric key to encrypt the ID/packet (col.

11 lines 38-53).

14.   Claims 20 & 21, as best understood, are rejected under 35 U.S.C. 103(a) as being

unpatentable over Lee in view of Ciacelli, as applied to claim 17 above, in further view of

Yaegashi and Schneier.

Regarding claim 20, Lee discloses receiving a decrypting key from the server and

discloses the possibility of requesting a payment with a credit card/authentication (col. 5 lines

54-67), but lacks explicitly authenticating a user and streaming decryption logic to receive data

from the server and play the data. However, Yaegashi teaches a similar system for the

distribution of information on a media where a user must log in to the information access

system/system that reads the recording medium (col. 10 lines 46-65). While Yaegashi does not

explicitly teach motivation for doing so, it is well-known in the art to use a user identification

and password to identify/verify/authenticate a user to another entity, as taught by Schneier (page

52). Therefore, it would have been obvious to one having ordinary skill in the art at the time the

invention was made to provide a user authentication interface to request a user authentication

password in response to a server request, and to send the data received from a user to the server,

receiving a decryption key from the server if the user is authenticated, as suggested by Lee (col.

5 lines 54-67) and Yaegashi (col. 10 lines 46-65). One of ordinary skill in the art would have

been motivated to perform such a modification to authenticate the user, as taught by Schneier

(page 52). As modified, Lee lacks streaming decryption logic. However, Ciacelli teaches the

concept that encrypting a data stream, one ensures that the information in the stream (such as

copyrighted material) is not exposed during the data transfer (col. 3 lines 25-64). Therefore, it

would have been obvious to one having ordinary skill in the art at the time the invention was

made to include streaming decryption logic to receive and decrypt data using the received key.

One of ordinary skill in the art would have been motivated to perform such a modification to

ensure that the content is not exposed during data transfer, as taught by Ciacelli (col. 3 lines 25-

64).

Regarding claim 21, Lee discloses the decryption key being a content decryption key

(col. 9 line 63 – col. 10 line 3) and, as modified by Ciacelli, a session key (defined by Schneier

as a key used with symmetric algorithms to secure message traffic (page 33)).

15.   Claim 25, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable

over Yaegashi in view of Ciacelli. Yaegashi discloses a reader (col. 9 lines 20-28) to read an

identification (col. 9 lines 1-10) and content/sensitive information (col. 8 lines 61-67) from a

secure medium/distribution CD (col. 9 lines 1-10), an authentication logic to receive

authentication/decryption key from the server indicating approval to read the content of the

secure medium (col. 9 lines 20-38), sending the content to an application/information access

system (col. 9 lines 50-59 & Fig. 1) and key logic to receive a decryption key from the server if

the user is authenticated (col. 11 lines 1-22). Yaegashi lacks explicit disclosure of the

application/information access system comprising a user interface to request user identification

in response to a server request and to send the data received from a user to the server. However,

it is inherent that such a user interface must exist to allow the user to enter access information

(col. 10 lines 47-65). Yaegashi further lacks an encryption logic further to encrypt the content

prior to sending the content to an application and a streaming decryption logic to receive data

from the secure device and decrypt the data using the key received and play the data. However,

Ciacelli teaches the concept that encrypting a data stream, one ensures that the information in the

stream (such as copyrighted material) is not exposed during the data transfer (col. 3 lines 25-64).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the

invention was made to encrypt the content prior to sending the content to an application and

include streaming decryption logic to receive and decrypt data using the received key. One of

ordinary skill in the art would have been motivated to perform such a modification to ensure that

the content is not exposed during data transfer, as taught by Ciacelli (col. 3 lines 25-64).

Allowable Subject Matter

16.   Claims 8, 19 & 22, as best understood, would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

17.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The patent references not relied upon were cited for general relevance in the art of copy protection for teaching various methods such as session keys to protect point-to-point communication, encrypted data on a storage medium, licensing servers and content key servers.

The Sibert article was cited for teaching copy protection using cryptography, specifically "Digibox" technology.

18.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Simitoski whose telephone number is (703)305-8191. The examiner can normally be reached on Monday - Thursday, 6:45 a.m. - 4:15 p.m.. The examiner can also be reached on alternate Fridays from 6:45 a.m. – 3:15 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on (703)308-4789.

Any response to this action should be mailed to:
Commissioner of Patents and Trademarks

Washington, DC 20231
Or faxed to:
(703)746-7239 (for formal communications intended for entry)
Or:
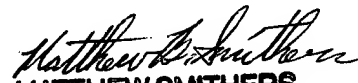(703)746-7240 (for informal or draft communications, please label "PROPOSED" or "DRAFT")
Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA 22202, Fourth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9000.

19.   Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJS
April 5, 2004

MATTHEW SMITHERS
PRIMARY EXAMINER
Art Unit 2137